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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,432	06/07/2001	David T. Berquist	56777USA3A.002	8956

32692 7590 08/10/2006

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EXAMINER
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KOYAMA, KUMIKO C

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	09/876,432		BERQUIST ET AL.	
	Examiner		Art Unit	
	Kumiko C. Koyama		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-24,39-49 and 75-102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-24,39-49 and 75-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

Amendment received on May 12, 2006 has been acknowledged.

### *Continued Examination Under 37 CFR 1.114*

1. The request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 12, 2006 has been entered.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3-8, 10-24 and 48-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 60 and 64-77 of copending Application No. 09/882,969 (herein after '969 application). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '969 application.

Re claim 1 of the present invention: Claim 1 of the present invention recites "A method of collecting information related to RFID tags associated with items of interest, comprising the steps of: (a) selecting a category of items using a user interface associated with an RFID reader; (b) using the RFID reader to interrogate at least one RFID tag associated with an item of interest; and (c) associating information related to the at least one item with the selected category."

Re claim 60 of '969 application: Claim 60 of the '969 invention recites "A method of interrogating RFID tags associated with items of interest, comprising the steps of: (a) selecting at least one category of items using a user interface associated with an RFID reader; (b) interrogating RFID tags associated with items, at least one of which is within the category of items; (c) categorizing information related to the at least one item(s) associated with the interrogated RFID tag(s) in at least one of the categories; and (d) ignoring any RFID-tagged-item that may not be categorized in at least one category."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 32-37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-16 and 42 of copending Application No. 09/755,714 (herein after '714 application). Although the conflicting claims are

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not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '714 application.

Re claim 32 of the present invention: Claim 32 of the present invention recites "A method of obtaining information related to items associated with RFID tags, comprising the steps of: (a) interrogating the RFID tags in an order; and (b) organizing the information in an order other than the order in which the tags were interrogated."

Re claim 37 of '714 application: Claim 37 of '714 application recites "A method of using an RFID reader for interrogating RFID tags associated with items of interest, by programming the RFID reader to provide specified information regarding each item of interest in a specified order on a user interface associated with the RFID reader, at least some of the information being selected from the group consisting of a name or title of the item, s serial or call number of the item, and a desired location for the item."

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Claim Objections*

5. Claims 41-47 are objected to because of the following informalities:

Re claim 41, line 7: "our" should be changed to --or--.

Re claims 42 and 45: The use of "if so" renders the claim vague and indefinite because it is unclear whether something is actually happening or not, and therefore, the limitation is not an active and positive statement. For examination purposes, the Examiner will assume that the item

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is not represented as absent for claim 42, and the item is not represented as present for claim 45, and consequently, no further action is taken.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-8, 12-16, 18-23, 75-84 and 87-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidsson (US 6,934,718) in view of Garber et al (US 6,232,870).

Re claims 1, 5, 6, 8, 12, 14, 18, 19, 21, 75-77, 80, 81, 83, 84, 87, 91 and 92: Davidsson discloses categorizing and retrieving items. Davidsson discloses that the user wishes to categorise the web page in terms of both sports and newspaper and so the mouse cursor 32 is moved to operate buttons 33 and 34 so as to dispense a graphical representation of both red and blue ink 39, 40 onto the web page displayed in window 38 (col 5, lines 40-44). Such disclosure teaches selecting at least two categories of items using a user interface, and the categories sports and newspaper are specified attributes and represents a portion of an entire group of items. Davidsson also discloses that web page A is displayed in window 28, ready to be book marked (col 5, lines 38-40), which shows that the web page was not associated with the categories selected. Davidsson also discloses that to this end, thumbnail data is assembled in a manner known per se and attached to the URL for Page A. Also, the marker signal flags CM1=1, CM2=1

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and CM3=0 are collocated with the URL and the thumbnail data (col 5, lines 47-52). Such disclosure teaches associating and categorizing the item with the category selected. Davidsson also discloses that the processor 9 runs a book marking process 28 such that book marked data corresponding to Table 2 is stored in the book marked web page cache 29 shown in FIG. 3 (col 5, lines 44-47), which teaches saving the categorized information in a database. Davidsson further discloses that it may be appropriate to bookmark a web page without using category marker signals (col 5, lines 59-61), which shows ignoring the item that may not be categorized in any of the categories.

Davidsson fails to disclose using an RFID reader to interrogate at least one RFID tag associated with an item and obtaining a list of RFID tagged items.

Garber teaches a method of using a portable RFID device with a group of items each having an RFID tag, inputting information to the device describing a certain item or class of items, scanning the RFID tags associated with each item in the group of items, receiving signals from each of the scanned RFID tags, and comparing the received signals to the information input to the device to determine whether the certain item or class of items are present among the group of items (col 18, lines 55+). Garber also discloses that items on a shelf were read by the RF reader, each would be compared with the list of items stored in memory (col 16, lines 40-47). The devices and applications are described with particular reference to library materials such as books, periodicals, and magnetic and optical media (abstract). Garber also discloses that the shelf location for an item is encoded directly in the RFID tag memory for that item (col 17, lines 30-35) and inputting information to the device describing a certain item or class of item (col 18, lines 58-60).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the teachings of Garber to the teachings of Davidsson to expand the usefulness of Davidsson in a library environment using an RFID tag because it is easier and faster for the user to retrieve or find books, periodicals, and magnetic and optical media when they are categorized according to the subject matter.

- Re claim 3: Davidsson further discloses a display device 2 (col 3, lines 28-31).

Re claims 4, 13, 20, 78, 79, 82, 88 and 93: As described above, Davidsson discloses that the categories are sports and newspaper. The categories are displayed on the display (Fig. 5).

Re claims 7 and 82: Davidsson further discloses that the book marking and retrieval process may be used to bookmark program information in a TV program guide in order to enable the user to categorise links to TV programs which may be stored in the storage medium (col 6, lines 50-57). Davidsson further discloses a display device 2 (col 3, lines 28-31).

Re claims 15, 16, 22, 23, 89, 90 and 94: Davidsson further discloses that the book marking and retrieval process may be used to bookmark program information in a TV program guide in order to enable the user to categorise links to TV programs which may be stored in the storage medium (col 6, lines 50-57). Davidsson further discloses that the storage device is a floppy disc drive, a hard disc, a CD or DVD ROM Drive (col 3, lines 9-10).

8. Claims 10, 11, 85 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidsson in view of Garber as applied to claims 8 and 83 above, and further in view of Beauchamp (US 6,886,011). The teachings of Davidsson as modified by Garber have been discussed above.



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Re claims 10 and 85: Davidsson as modified by Garber fails to teach that the categories are mutually exclusive.

Beauchamp discloses that the other category systems referenced may be mutually exclusive or non-mutually exclusive systems (col 9, lines 8-10).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the teachings of Beauchamp to the teachings of Davidsson as modified by Garber because when categories are mutually exclusive there is no overlap between categories and as a result, there are less items to look over for each category, and therefore, provides a faster search.

Re claims 11 and 86: Davidsson as modified by Garber fails to teach that the categories are not mutually exclusive.

Beauchamp discloses that the other category systems referenced may be mutually exclusive or non-mutually exclusive systems (col 9, lines 8-10).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the teachings of Beauchamp to the teachings of Davidsson as modified by Garber because when categories are not mutually exclusive, it provides the items to be found in more one category, and therefore, when the user is looking for a particular subject, it provides the user to find the article in more than one category and therefore, providing the flexibility and increase in speed to find a certain item.

9. Claims 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidsson in view of Garber as applied to claim 16 above, and further in view of Parulski et al (US 5,633,678). The teachings of Davidsson as modified by Garber have been discussed above.

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Davidsson as modified by Garber fails to teach a flash memory card.

Parulski teaches a flash EPROM memory (col 4, lines 54-55).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the teachings of Parulski to the teachings of Davidsson as modified by Garber because flash EPROM memory is a small device that contains a lot of memory space and therefore, it is easy for the user to carry around such compact device.

10. Claims 39-49, 95-98 and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber et al (US 6,232,870) in view of Barritz et al (US Patent Application Publication 2002/0008621).

Re claims 39-42, 45, 48 and 95-98: Garber discloses a method of using a portable RFID device, comprising the steps of inputting an algorithm to the device that describes an ordered set of items (col 19, lines 18-20). Garber discloses scanning a plurality of items having RFID elements to obtain information from those elements (col 19, lines 21-23), wherein the RFID elements are RFID tags associated with items (abstract) and such disclosure teaches interrogating RFID tags, each associated with an item, to obtain information. Garber also discloses that the RFID device is also used to verify the order of materials on a shelf. The device is scanned across one or more rows of items. The device reads each item and indicates, to the operator, which items are not shelved in the correct order. As input, the device has access to the shelving algorithm used by the library for the section being scanned. Possible algorithms include Dewey Decimal order, Library of Congress order, and Author last name/Title order (col 17, lines 16-26). Such disclosure teaches using the information obtained in the interrogation step for performing a primary operation of determining whether the items are in a predetermined order within a

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physical storage area. Garber also discloses that the RFID tags in library materials may be checked out automatically by interrogating the RFID tag to determine the identity of the material (col 3, lines 15-20).

Garber fails to teach determining the presence or absence of the items and updating the inventory database to reflect the determined presence or absence of the items.

Barrtiz teaches that when a bar code is scanned, the scanned code is verified against the database. If an entry is not found, the user may be prompted to enter descriptive information about the item at which point a new inventory item is created (Page 2, Paragraph [0045], lines 1-5).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Barrtiz to the teachings of Garber in order to ensure that the database reflects the same information as the inventory to increase the accuracy of the information, and therefore, the user can quickly retrieve the accurate status of the inventory when needed.

Re claims 43, 44, 46, 47 and 49: Garber teaches a touch-screen display (col 15, lines 1-5).

Re claim 101: Garber teaches that after the RFID device reads the RFID tag, the device transmits the item identification information to a computer having software (col 11, lines 40-45).

Re claims 99 and 100: Garber fails to teach creating a list of items that are not on the ordered list.

Barrtiz teaches that when a bar code is scanned, the scanned code is verified against the database. If an entry is not found, the user may be prompted to enter descriptive information about the item at which point a new inventory item is created (Page 2, Paragraph [0045], lines 1-

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5). Since Barritz verifies against the database and locates the entry, Barritz also teaches simultaneously determining the presence or absence of the item because if the item is verified, it is present, and if the item is not verified, then it is absence. With Barritz teaching the item is either present or absence, therefore, it must be one or the other.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Barritz to the teachings of Garber as modified by Parulski such that the user is notified to create a new category for the non-matching item to ensure that the each and every item is categorized. By ensuring that every item belongs to a category, the user is able to locate the item in a faster manner.

11. Claim 102 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Barritz as applied to claim 97 above, and further in view of Parulski et al (US 5,633,678). The teachings of Garber as modified by Barritz have been discussed above.

Parulski teaches a removable data storage device

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to modify the teachings of Parulski to the teachings of Davidsson as modified by Garber because flash EPROM memory is a small device that contains a lot of memory space and therefore, it is easy for the user to carry around such compact device. Such modification provides the user to easily transport the list to other devices such that other devices will also have the same list to share.

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*Response to Arguments*

12. Applicant's arguments with respect to claims 1, 3-8, 10-24, 39-49 and 75-102 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 571-272-2394. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Kumiko C. Koyama*  
Kumiko C. Koyama  
August 07, 2006

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PRIMARY EXAMINER